

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Nyberg et al.

Application No.: 10/796,424

Filed: 3/8/2004

Title: **FEEDSTOCK COMPOSITION
AND METHOD OF USING SAME FOR
POWDER METALLURGY FORMING
OF REACTIVE METALS**

Group Art Unit: 1793

Confirmation No. 1883

Examiner: Ngoclan Thi Mai

Attorney Docket No: 14185-B

PETITION TO WITHDRAW HOLDING OF UNINTENTIONAL ABANDONMENT

MAIL STOP PETITIONS

Office of Petitions

Commissioner for Patents

PO BOX 1450

Alexandria VA 22313-1450

Dear Commissioner,

Please withdraw the holding of abandonment in this case. The grounds for this petition are set forth in the concurrently submitted declaration of Allan Tuan and are set forth below as follows:

- 1) This abandonment was entirely unintentional. The entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional.
- 2) This petition is timely filed within 2 months of the receipt of the notice of abandonment.
- 3) The applicable petition fee for this action is attached:

- 4) The other supporting facts that explain the present status of this application are set forth as follows:

- 1) The relevant facts related to this petition begin with the Final Office Action sent from the USPTO on May 13, 2007. This Office Action set forth an indication that, while various claims of the Application were maintained as rejected, several claims of the application were indicated as allowable (claims 41, 42 and 152) and several other claims (6, 8, 27, 29-35, 37-39.43-53) were objected as being dependent upon a rejected base claim but were indicated as being allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claim. A shortened statutory period of three months was provided in which to file a reply. (See Exhibit 1 to Declaration of Allan Tuan).

- 2) On September 10, 2007 a reply, together with a fee and petition for a one month extension was electronically filed and received at the United States Patent and Trademark Office. This reply, a copy of which is attached as Exhibit 2 to the Declaration of Allan Tuan, thankfully acknowledged the Examiner's prior allowance of various claims and provided amended claims that included the subject matter that the Examiner had previously indicated as being allowable. In this amended form, the claims of the application were then in condition for allowance, or so the Applicant believed.

- 3) In view of these amendments, Allan Tuan the patent practitioner who was prosecuting the case, then made a point of reviewing PAIR on a regular basis looking for the date in which a Notice of Allowance would be sent. Nothing appeared. With the statutory deadline approaching, Allan Tuan placed a call to Examiner Mai, who was the Examiner assigned to this case, on November 13, 2007. She was not available but returned his phone call the following day. In this conversation, Examiner Mai indicated that while PAIR showed that the aforementioned response had been received by the USPTO on September 10, 2007, that this had not been entered into the PALM system at the USPTO, therefore she had not reviewed the Office Action. See Declaration of Allan Tuan paragraph 4).

- 4) The Examiner then indicated that, prior to the end of the statutory period, she would review the office action and provide a response. (See Declaration of Allan Tuan paragraph 5). In a subsequent phone conversation Examiner Mai indicated to Mr. Tuan that a Notice of Allowance had been prepared and sent from the USPTO on Nov. 15, 2007.

5) No other correspondence related to this case was then received from the USPTO until January 16, 2008 when a notice was received that indicated that the application was abandoned. This notice of abandonment that no Response to the May 17, 2007 Final Office Action had been received and that the Response which had been received on September 10, 2007 was non-responsive. (See Notice of Abandonment, Exhibit 3).

6) A phone call to the USPTO revealed that in a subsequent review of the application, the previous findings of allowability had been over turned, and thus the prior response which put the application in condition for allowance in view of previous representations made by the USPTO were now null and void. (See Declaration of Allan Tuan paragraph 7)

7) Applicant never was provided with this Notification and thus never had an opportunity to respond to the new rejection. The Applicant relied upon the representations which had been made by the Examiner and amended the application in a way so as to incorporate the previously designated subject matter into a form that would allow for this application to pass on for allowance.

8) Applicant respectfully submits that in as much as the application contained allowable subject matter and an amendment was made relying upon these representations that included this previously identified subject matter, that the Applicant's September 10, 2007 response which included both a fee for an extension of time as well as an authorization to the USPTO charge additional fees, was timely filed and responsive to the latest set of statements that had been made by the USPTO. These actions on the part of the Applicant clearly demonstrate that there was no intent in any way to allow this application to go abandoned. To the contrary, these facts clearly show that it was the intent of the Applicant to move this application forward to obtain allowance of this application.

The subsequent action by the USPTO, withdrawing the allowance of these previously allowable claims, and designating the application abandoned because Applicant's prior response failed to address the USPTO's subsequent silent rejections, clearly demonstrate a set of circumstances where abandonment of the application should not have taken place, and the Applicant cannot be punished for failing to respond to rejections that he did not know existed.

Therefore, Applicant respectfully requests that the status of Abandonment of this Application be withdrawn, and that if a determination has been made that the prior allowance of various claims of the application was in err that notice of the USPTO's findings be provided to Applicant so that these findings may be addressed.

DATED this 11 day of February, 2008.

Very respectfully,

A handwritten signature in black ink, appearing to read "Allan C. Tuan", written over a horizontal line.

Allan C. Tuan
Reg. No. 55,689